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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,259	01/10/2002	Bryan Rennecamp	RCP 6014	8444

321 7590 07/15/2003

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/044,259	RENNECAMP, BRYAN	
	Examiner	Art Unit	
	Carlos Lopez	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-14 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

Response to Amendment

Amendment filed on 5/5/03 obviates drawing objections, and 35 USC 102 (b) rejections of Paper No. 3.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 5, the phrase "washer type screw" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "washer type screw"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, and 12-14 are rejected under 35 U.S.C. 103(a) as unpatentable over Hill (US 5,967,310). Hill's second embodiment recited in claim 2 and in column 3 lines 18-32, discloses a smoking apparatus having smoking material receptacle 30 in the body of the smoking apparatus and a receptacle opening at the top of the smoking

Art Unit: 1731

apparatus. The second embodiment includes a lid having a width, bottom, depth, and external walls (lid 40) with a constant peripheral cross section. Additionally the second embodiment lacks the third recess 32. In view that Hill teaches that its disclosed invention provides for smoking apparatus that may be easily and efficiently manufactured (Column 2, lines 60-65), low cost of manufacturing in regards to material and labor (Column 3 lines 1-8), it is assumed that Hill's second embodiment, lacking a third recess 32, would have a body with a constant peripheral contour cross sections as implied in Figure 1 if it lacked recess 31. Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have provided a smoking apparatus having a body and a lid with constant peripheral cross section in order to reduce labor cost as taught by Hill.

As for claim 2, as shown in figure 1, the smoking body lacking recess 31 would include a lid 40 and body 14 with corresponding constant peripheral cross sections.

As for claims 3-5, the lid 40 is pivotably attached to the body 14 with screw 48.

As for claim 6, the wood grain running in the same direction as the lid and body is an obvious matter of design choice.

As for product-by-process claims 7-8, the process limitations do not change the end product and therefore reads on Hill's disclosed smoking apparatus. See MPEP 2113.

As for claim 9, in view of figures 1 and 2 disclosing a pipe receptacle 28, the distance of the pipe receptacle and smoking material receptacle is greater than the lid depth.

As for claim 10 reciting sidewalls of the smoking apparatus having arcuate contours, is an obvious matter of design choice and is encompassed by the term "main body" in claim 2.

As for claims 12-13, provides an obvious matter design of choice with process limitations that do not change the end product and whose end product is encompassed by the term "main body" in claim 2.

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose or reasonably suggest providing a replacement lid, with a constant peripheral contour, at the bottom of the smoking apparatus body.

Response to Arguments

Applicant's arguments filed 5/05/03 have been fully considered but they are not persuasive. While it is noted to Applicant that Hill does not have a claim 8, the Examiner interprets it as a typing error that should have read as claim 2 of Hill. Applicant argues that claim 8(2) of Hill includes a third recess. However there is no recitation of a third recess in claim 2 of Hill.

Applicant argues that all the figures of Hill include a recess. As recited above the figures are not being relied upon to show the absence of a third recess.

Thirdly, Applicant argues that Hill makes no mention of an embodiment lacking a third recess. Applicant is directed to claim 2 of Hill, not reciting a third recess.

Fourth, Applicant argues that the cited paragraph at col. 3 lines 18-32 is describing additional features of Hill's invention and not a separate embodiment, hence it would have a third recess. It is noted that if Hill was merely describing additional elements of the cited invention, there would be no need and would rather be redundant to further recite features that have formerly been cited such as a first recess, second recess, cover plate and last but not least a fastener. However, if Applicant's interpretation of said passage is maintained, Applicant is directed to claim 2, explicitly showing a smoking apparatus lacking a third recess.

As for the fifth argument, Applicant is again directed to claim 2 in conjunction with the cited passage explicitly showing a smoking apparatus lacking a third recess.

As for applicant's arguments presented to claims 9 and 10, it is noted that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP 2114R1. Claim 9 specifically reciting that distance between the openings of the pipe receptacle and smoking material is greater than the depth (thickness) of the lid, is clearly shown in figures 1 and 5 of Hill. Thus the claimed structural limitations would be expected to provide an unobstructed access to both openings based on the structural limitations recited in claim 9.

Art Unit: 1731

In regards to applicant's arguments directed to claim 13, the term "main body" encompasses a contour shape body, which is clearly envisaged in view of the prior art cited.

In regards to arguments directed to claim 5, the language noted by applicant is not recited in claim 5.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers

Art Unit: 1731

for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


STEVEN P. GRIFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

C.L
July 1, 2003